

Remarks

This Amendment and the following remarks are intended to fully respond to the Office Action dated April 12, 2005. In this Office Action, claim 17 is rejected under 35 U.S.C. § 112; claim 23 is rejected under 35 U.S.C. § 101 because the invention claimed therein recites non-statutory subject matter; claims 1-4, 7-8, 10-11, 21-28, 30-32, and 34-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,961,561 (“Wakefield, II”); claims 12-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,735,293 (“Doherty et al.”); claims 21-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,694,323 (“Koropitzer et al.”); claims 5 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wakefield in view of Doherty et al.; and claims 9 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wakefield II in view of U.S. Patent No. 4,905,163 (“Garber et al.”).

In this Amendment, claim 23 has been amended to address the aforementioned §101 rejection, claims 1, 2, 9, 21, 23-26, and 33 have been amended and claim 22 has been canceled. Reconsideration of the application is respectfully requested in light of the above amendments and in consideration of the following remarks.

A. Claim Rejection under 35 U.S.C. §112

With regard to the claim rejection under 35 U.S.C. §112, Applicant respectfully points out that claim 12 is the base independent claim to which claim 17 depends. Therefore, because claim 12 recites “a field service provider,” the phrase “the field service provider” in claim 17 is believed to have proper antecedent basis.

B. Claim Rejections under 35 U.S.C. §101

Claim 23 is hereby amended to address the Examiner’s 35 U.S.C. §101 rejection. Also, claims 2 and 26 are hereby amended in similar fashion, though not rejected in the Office Action.

C. Claim Rejections – 35 U.S.C. § 102

Each independent claim pending in the present application currently stands rejected under 35 U.S.C. §102 under one or more of the following U.S. patents: Wakefield, II, Doherty et al. and Koropitzer et al. Keeping in mind that a claim can be rejected as anticipated by a prior art reference only if each and every limitation “as set forth in the claim” is found in the reference,

MPEP §2131 (citing *Verdegaal Bros. V Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d. 1051, 1053 (Fed.Cir. 1987), Applicant respectfully submits that none of these cited references provides support for a proper anticipatory rejection of any of the claims in this application. Prior to addressing the distinctions between the claimed invention and each of these references in detail, the claimed invention is now briefly described below.

In general, the present invention is directed to remotely providing services to customers by way of field service providers. The field service providers interact with a server computer (referred to herein as “network advisory system”) using network devices to gather advisory information related to these services. The advisory information is maintained on the network advisory system in the form of database records and may be data type and customer specific. In addition, the advisory information is stored in at least some of these records in a plurality of languages. In response to a field service provider accessing the network advisory system, an embodiment of the claimed invention involves retrieving advisory information for that field service provider that is formatted in a language that the field service provider can understand. In this regard, the advisory information is “customized” for that field service provider.

Turning now to the cited art, the Examiner’s rejections are now addressed in turn with separate reference to each reference.

1. §102 Rejections in view of Wakefield, II

As noted above, claims 1-4, 7-8, 10-11, 21-28, 30-32, and 34-35 stand rejected under 35 U.S.C. §102(b) over Wakefield, II. Prior to addressing these rejections, it is helpful to briefly describe the teachings of Wakefield, II, as set forth in the following paragraph.

In general, Wakefield, II is directed to a software program (referred to in Wakefield, II as a "TDP system") for remotely monitoring and controlling operation of an electric or motorized wheelchair. The wheelchair includes a control module responsible for locally controlling and monitoring operation of the wheelchair, including collecting data associated with the various components (e.g., joystick, batteries, etc.) on the wheelchair. The control module is coupled to a modem for transmitting collected data to and receiving control data from a remote computer on which the TDP system executes. The modem and the remote computer exchange data over a data communication network, such as the wireless link 14 shown in FIG. 1 of Wakefield, II. The TDP system also provides a user interface module for enabling users of the remote computers to monitor data collected by the control module as well as input control commands to the module.

Turning now to amended claims 1 and 25, the present invention is recited as a method and a computer process on a computer readable medium, respectively, for providing advisory information to a field service provider. The method and computer process each involve accessing a data-type record in which the advisory information is formatted in a plurality of languages and selecting from that record advisory information in the language associated with the field service provider. Likewise, amended claim 21 recites the claimed invention in system form having a database that stores advisory information in a plurality of language formats as well as a means for selecting advisory information from the database in a specific language format. Even further, claim 21 recites an embodiment of the present invention in which selection of the specific language format is effectuated based on a provider identifier associated with the field service provider.

With these limitations in mind, each of these independent claims therefore provides for the selection of advisory information that is “customized” to the language of a specific field service provider. In contrast, Wakefield, II only teaches the presentation of advisory information to users of the TDP system in a single language – English. See FIG. 6. That is, the TDP system displays information in the English language regardless of the user’s preferred language. Wakefield II consequently fails altogether to teach the selection of advisory information formatted to a language associated with a requesting field service provider.

Even further, by failing to teach or suggest storage of advisory information in multiple languages, Wakefield, II lacks any motivation whatsoever for modifying the TDP system in the direction of the present invention. Accordingly, Wakefield, II would not be a proper reference for use in rendering the invention recited in claims 1 and 25 obvious under 35 U.S.C. §103. *See In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed.Cir. 1984); *See Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (BdPatApp&Int 1985); *See Ex parte Chicago Rawhide Mfg. Co.*, 223 U.S.P.Q. 351, 353 (BdPatApp&Int 1984). That is, one of skill in the art reading Wakefield, II would not have realized the desirability to modify the TDP system to provide for the presentation of advisory information to field service providers in a language specific to each provider.

For at least the foregoing reasons, independent claims 1, 21 and 25 are believed allowable over Wakefield, II, both from an anticipatory and obviousness standpoint. Claims 2-4, 7-8, 10-11, 22-25, 26-28, 30-32, and 34-35 depend directly or indirectly from these independent claims and, consequently, are also believed allowable over Wakefield II.

2. §102 Rejections in view of Doherty

As noted above, claims 12-20 stand rejected under 35 U.S.C. §102(b) over Doherty et al. Prior to addressing these rejections, it is helpful to briefly describe the teachings of Doherty et al., as set forth in the following paragraph.

Generally, Doherty et al. teaches a system for providing reliable service in the telecommunications industry. The Services Provisioning and Assurance system (SPA) facilitates installation and repair of equipment by automating some aspects of the installation process and then monitoring faults generated by malfunctioning customer equipment. In some cases, the SPA is able to repair faults on its own. Otherwise, the SPA sends a message describing the needed service to a field service provider via electronic mail or an alphanumeric page.

In similar vein to claims 1, 21 and 25, claim 12 recites a method in which advisory information is provided to a field service provider in a language specific to the provider. To accomplish this, the method of claim 12 involves using an identifier associated with the field service provider to select a language format specific to that provider. Because the format in which the advisory information is presented to the field service provider is based on that provider's identifier, the advisory information is considered to be "customized," as explicitly recited in claim 12.

Doherty et al. does not disclose providing advisory information in a customized language format associated with a given field service provider as specified by the provider identifier. Rather, Doherty et al. discloses *transmitting* information via either an alphanumeric page or electronic mail. The information that is transmitted is the same in either case; it is not stored or relayed in a language specific to the field service provider.

For at least the foregoing reasons, independent claim 12 is believed allowable over Doherty et al. Claims 13-20 depend directly or indirectly from claim 12 and, consequently, are also believed allowable over Doherty et al.

3. §102 Rejections in view of Koropitzer

As noted above, claims 21-24 stand rejected under 35 U.S.C. §102(b) over Koropitzer. Prior to addressing these rejections, it is helpful to briefly describe the teachings of Koropitzer, as set forth in the following paragraph.

Koropitzer generally describes a process and system for monitoring the amount of revenue generated by and the repair history for remote laundromats having laundry machines.

Koropitzer teaches that monitoring cash collections can lead to various types of analyses regarding the financial aspects of operating laundromats and that monitoring repair history can indicate whether a malfunctioned machine has been repaired. Such monitoring is administered by a network having a main controller unit (MCU) and multiple site controller units (SCU). The SCU's are located at each of the remote laundromats and collect information regarding cash collections and repair history for communication to the MCU. In this regard, the location of the MCU is referred to in Koropitzer as a "monitoring site." See Koropitzer, at Col. 12, line 60.

Claim 21 discloses a database storing the generated advisory information in a plurality of language formats. Further, claim 21 discloses a means for selecting the language in which to format information for the field service provider based on the provider identifier. In this way, the advisory information is customized to each field service provider.

Koropitzer does not disclose a database storing the generated advisory information in a plurality of language formats. The MCU communicates with each SCU through a communication line, typically a phone line, which is connected to a modem. The MCU and SCU's communicate through a common, fixed protocol. There is no need to store advisory information in a plurality of language formats because communication at this level is between two compatible devices. Koropitzer does not teach or suggest storing information in a plurality of languages. Further, Koropitzer does not disclose a means for selecting advisory information from the database for presentation to the field service provider, wherein the selecting means selects the advisory information in one of the plurality of language formats based on the provider identifier. Because Koropitzer does not store advisory information in a plurality of languages, there is no ability or need to select the language in which to display advisory information.

For at least the foregoing reasons, independent claim 21 is believed allowable over Koropitzer. Claims 22-24 depend directly or indirectly from claim 21 and, consequently, are also believed allowable over Koropitzer.

D. Claim Rejections – 35 U.S.C. § 103

In the Office Action, dependent claims 9 and 33 were rejected as being unpatentable over Wakefield, II in view of Garber et al. For reasons described in detail below, Applicant respectfully traverses the Examiner's rejections of these claims under 35 U.S.C. §103(a).

Wakefield, II has been described above. Garber et al. is generally directed to a computerized information presentation system for dynamically organizing information in order to present a user with meaningful access to large bodies of information. As such, Garber et al. discloses a system of dynamically selecting information to display to a user based on the user's input. In the case where Garber et al. is applied to displaying medical records, the content displayed may be different depending on whether the user is a nurse, doctor, or medical technician. Garber et al. discloses placing information into different categories for presentation, but does not discuss storing information in a plurality of computer-based or natural languages.

As stated in the Office Action, neither Wakefield, II nor Garber et al. recites each and every limitation of claim 9 or claim 33 in the present application and, therefore, neither reference anticipates either claim. As such, the Examiner relies on a combination of these references to reject claims 9 and 33 under 35 U.S.C. §103(a). However, as articulated in more detail below, these rejections are improper because the Office Action fails to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). *See MPEP, at §706.02(j)*. Specifically, the Office Action fails to prove that Wakefield, II and Garber et al. collectively teach or suggest all limitations recited in either claim 9 or claim 33. See MPEP §2143.03 (citing *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974)). Additionally, the Office Action fails to properly assert a suggestion or motivation in the cited references or in the knowledge generally available to one of ordinary skill in the prior art to combine Wakefield, II with Garber et al. See MPEP §2143.03 (citing In Re Rouffet, 149 F.3d 1350, 1357 (Fed.Cir. 1998)). These basic criteria required for finding a *prima facie* case of obviousness, neither of which has been satisfied by the Examiner, are now addressed in turn.

First and foremost, the combination of Wakefield, II and Garber et al. fails to collectively teach each and every limitation recited in claim 9 or claim 33. Specifically, claims 9 and 33 recite determining the language in which the customized advisory information is formatted based on a provider identifier input by the field service provider. As previously discussed, Wakefield, II only teaches the presentation of advisory information to users of the system in a single language. In the Office Action, the Examiner properly identifies that Wakefield, II doesn't teach such a feature and consequently brings in Garber et al. to meet this limitation. However, Garber et al. does not teach such a feature either.

Although Garber et al. discloses displaying alternative information content to users based on specified user identifiers, the content is always displayed in the same language. In contrast, the present invention, as recited in claims 9 and 33, delivers the information to a user in a language associated with that user and, consequently, provides for different users being able to receive the same information in different languages. Garber et al. does not teach storing the same information in a plurality of languages and thus fails altogether to discuss selecting a language in which to format information. Further, claims 9 and 33 recite using a provider identifier in regards to language selection. By failing altogether to teach the storage of information in a plurality of languages, Garber et al. necessarily cannot teach nor provide a motivation for selecting one of the plurality of languages formats based on a specified user identifier.

Secondly, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). The motivation, suggestion or teaching to support an obviousness-based rejection may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999).

Applying the foregoing canons of law to the instant rejections, neither Wakefield, II nor Garber et al. includes, implicitly or explicitly, a motivation, suggestion or teaching that would result in the combination of these references in the direction of the claimed invention. Whereas Wakefield, II pertains to a software system for remotely monitoring and controlling operation of an electric or motorized wheelchair, Garber et al. is directed to a system for dynamically organizing diverse information in such a way as to draw out specific content for the user. These two patents are directed to unrelated markets; Wakefield, II relates a system of servicing a wheelchair for use by a wheelchair technician, while Garber et al. discloses a system for accessing large bodies of information in a meaningful way. The Office Action offers no

explanation for making this combination other than to state conclusively, without support, that it would be obvious to one skilled in the art to do so.

Finally, the Office Action does not provide evidence that knowledge of one skilled in the art would provide the motivation, suggestion or teaching to combine these references. Nor does the Office Action provide any evidence that the teaching, suggestion or motivation is implicit in the prior art. The only conclusion that can be reached from the alleged combinability of these references is impermissible hindsight gleaned from the present invention. See, e.g., Ex parte Haymond, 41 USPQ2d 1217, 1220 (BdPatApp&Int 1996) (the examiner “may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis.”). Thus, a motivation to combine these references to render the invention recited in claims 9 and 33 is definitely not implicit from the prior art as a whole.

In view of the foregoing, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness of claims 9 and 33, and that these claims are even further allowable over Wakefield, II and Garber et al.

Conclusion

This Amendment fully responds to the Office Action mailed on April 12, 2005. Still, the Office Action may contain arguments and rejections and that are not directly addressed by this Amendment due to the fact that they are rendered moot in light of the preceding arguments in favor of patentability. Hence, failure of this Amendment to directly address an argument raised in the Office Action should not be taken as an indication that the Applicant believes the argument to have merit. Furthermore, the claims of the present application may include other elements, not discussed in this Amendment, which are not shown, taught, or otherwise suggested by the art of record. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability.

Should the Examiner have any remaining questions or concerns, he/she is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns. No fees are believed due for submission of this Amendment. However, if this is not the case, please charge any such fees to Deposit Account No. 13-2725. Alternatively, please credit any overpayment to Deposit Account No. 13-2725.

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Respectfully submitted,





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